

a<sup>1</sup>  
cont

c) determining the change in concentration for at least one of the following: L-histidinol phosphate, H<sub>2</sub>O, L-histidinol, and/or orthophosphate, wherein a change in concentration for any of the above substances indicates that said test compound is a candidate for an antibiotic.

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13. A method for identifying a test compound as a candidate for an antibiotic, comprising:

- a<sup>2</sup>
- a) contacting L-histidinol and orthophosphate with a histidinol-phosphatase;
  - b) contacting L-histidinol and orthophosphate with a histidinol-phosphatase and a test compound; and
  - c) determining the change in concentration for at least one of the following: L-histidinol phosphate, H<sub>2</sub>O, L-histidinol, and/or orthophosphate, wherein a change in concentration for any of the above substances indicates that said test compound is a candidate for an antibiotic.
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## II. Remarks

Claims 8 and 13 are herein amended by removal of the phrase "between steps (a) and (b)" to accurately reflect that recited in Applicants' specification at page 19, lines 30-31, and page 20, lines 8-9. Therefore, no new matter has been added.

## III. Restriction Election

The Examiner has required restriction between Group I (Claims 1-7), Group II (Claims 8-12 and 18), Group III (Claims 13-17 and 19), Group IV (Claims 20-25), Group V (Claims 26-32), Group VI (Claims 33-40), Group VII (Claims 41-43), Group VIII (Claims 44, 45 and 47), Group IX (Claim 46) and Group X (Claims 48-49).

Applicants hereby provisionally elect, with traverse, to prosecute Group II

(Claims 8-12 and 18) drawn to methods for identifying a test compound. In light of the preliminary claim amendment and the remarks that follow, Applicants respectfully assert that the rejoinder of Group II (Claims 8-12 and 18) and Group III (Claims 13-17 and 19) is proper and request that Group II and Group III are recombined. In the event of the rejoining of Group II and Group III, Applicants elect to prosecute Claims 8-19 present in both Group II and Group III.

Applicants reserve the right to file divisional applications or take other appropriate measures deemed necessary to protect the inventions in the remaining claims without prejudice thereon.

**IV. Restriction of Group II and Group III is respectfully traversed.**

The requirement to restrict Applicants' claims into Group II and Group III is respectfully traversed. In light of the preliminary claim amendment above and the remarks that follow, Applicants respectfully assert that the rejoinder of Groups II and III (Claims 8-19) is proper and request that Group II and Group III are recombined.

The amended claims in Group II are drawn to a method for identifying a compound as an antibiotic by contacting a histidinol-phosphatase with reactants L-histidinol phosphate and H<sub>2</sub>O in the presence and absence of the compound and determining a change in concentration for at least one of L-histidinol phosphate, H<sub>2</sub>O, L-histidinol, and/or orthophosphate, wherein a change in concentration for any of the substances indicates the compound as an antibiotic. The claims in Group III are drawn to a method for identifying a compound as an antibiotic by contacting a histidinol-phosphatase with reactants L-histidinol and orthophosphate in the presence and absence of the compound and determining a change in concentration for at least one of L-histidinol phosphate, H<sub>2</sub>O, L-histidinol, and/or orthophosphate, wherein a change in concentration for any of the substances indicates the compound as an antibiotic.

Applicants respectfully assert that Groups II and III are related inventions, not distinct from each other, and the reasons proposed for distinctness in the Office Action are incorrect. The Office Action provides no criteria, according to MPEP 806.05(c)-806.05(i), to demonstrate the distinctness of Applicants' Groups II and III. Instead, the proposed reasons for distinctness are that "each requires materially different reagents, had

different modes of action, different functions and different effects.” *Office Action* page 3, No. 2. Applicants assert that, in fact, the mode of action, the function, and the effect of amended Claim 8 from Group II and amended Claim 13 from Group III are the same. For example, Applicants’ amended Claims 8 and 13 are both directed to a method for identifying a compound as an antibiotic by measuring the activity of a histidinol-phosphatase in the presence and absence of the compound. Furthermore, both amended Claims 8 and 13 are directed to the same enzyme catalyzed reaction and to determining a change in concentration of the same four substances. As for the different reagents, it is unclear to Applicants how the fact that different reagents are required to measure the same enzymatic reaction in the forward and reverse directions is relevant to the issue of distinctness.

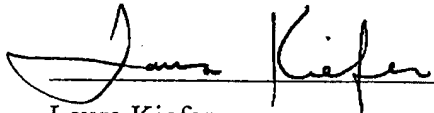
Therefore, the necessary criterion has not been provided for a demonstration of distinctness of Applicants’ Groups II and III. “Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 USC 121 is never proper (MPEP 806.05).” *MPEP* 808.02. Accordingly, Groups II and III are improperly restricted and Applicants respectively request the rejoinder of Groups II and III.

Furthermore, an appropriate explanation of the reasons for insisting on restriction has not been provided in the Office Action. It is stated at *MPEP* 808.02 that “[w]here the related inventions as claimed are shown to be distinct under the criteria of *MPEP* 806.05(c)-806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) Separate classification thereof ... (B) A separate status in the art when they are classifiable together ... (C) A different field of search.” The following proposed explanations for restriction are insufficient: “a. have acquired a separate status in the art as shown by their different classification; b. have different and separately burdensome: manual and/or computer: structure, name and bibliographical searches; and c. have divergent subject matter.” *Office Action*, page 4, No. 7. The amended claims of Groups II and III have the same classification, are directed to the same enzyme, the same four reactants, and the same enzymatic reaction. Therefore, it is not possible that the amended claims of Groups II and III require a separate status in the art or a different field of search. Accordingly,

the amended claims of Groups II and III are improperly restricted and Applicants respectfully request that they be rejoined.

In light of the foregoing, Applicants respectfully request that the claimed invention be regrouped such that Group II and Group III are recombined into Claims 8-19. Applicants submit that the case is in condition for prosecution and such action is respectfully requested. However, if any issue remains unresolved, Applicants' agent welcomes the opportunity for a telephone interview to expedite allowance and issue.

Respectfully submitted,



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**MARKED UP VERSION OF THE CLAIMS TO SHOW CHANGES MADE**

8. **(Once amended)** A method for identifying a test compound as a candidate for an antibiotic, comprising:
- a) contacting L-histidinol phosphate and H<sub>2</sub>O with a histidinol-phosphatase;
  - b) contacting L-histidinol phosphate and H<sub>2</sub>O with histidinol-phosphatase and a test compound; and
  - c) determining the change in concentration for at least one of the following: L-histidinol phosphate, H<sub>2</sub>O, L-histidinol, and/or orthophosphate,
- wherein a change in concentration for any of the above substances **[between steps (a) and (b)]** indicates that said test compound is a candidate for an antibiotic.
13. **(Once amended)** A method for identifying a test compound as a candidate for an antibiotic, comprising:
- a) contacting L-histidinol and orthophosphate with a histidinol-phosphatase;
  - b) contacting L-histidinol and orthophosphate with a histidinol-phosphatase and a test compound; and
  - c) determining the change in concentration for at least one of the following: L-histidinol phosphate, H<sub>2</sub>O, L-histidinol, and/or orthophosphate,
- wherein a change in concentration for any of the above substances **[between steps (a) and (b)]** indicates that said test compound is a candidate for an antibiotic.